

#81 Prior Art

PATENT  
Attorney Docket No. 6530.0008-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
Charles R. SLATER )  
Rule 53(b) Divisional of: )  
Serial No.: 08/354,992 )  
Filed: October 23, 1998 )  
For: BIPOLAR ENDOSCOPIC )  
SURGICAL SCISSOR BLADES )  
AND INSTRUMENT )  
INCORPORATING THE SAME )

Parent Information:  
Group Art Unit: 3309

Examiner: M. Peffley

JC518 U.S. PTO  
09/177502  
10/23/98



Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

**INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(b)**

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b), Applicant brings to the attention of the Examiner the documents listed on the attached PTO 1449. This Information Disclosure Statement is being filed with the above-referenced application. Copies of the listed documents are attached.

Applicant further wishes to bring to the Examiner's attention that the parent application of this case (Serial No. 08/354,992) is involved in Interference No. 103,765 currently pending in front of Administrative Patent Judge William F. Pate III. (Applicant Slater recently abandoned the contest as to the count in this interference on October 6, 1998.) In addition, a separate divisional application of that parent application, having

Serial No. 08/806,386 and filed on February 27, 1997, is involved in Interference No. 104,190 currently pending in front of Administrative Patent Judge Pate.

On June 9, 1998, in the first-mentioned Interference No. 103,765 involving the parent application, Applicant Slater filed a request for consent to amend the parent application by canceling claims 24-29 and to file the present Rule 53(b) divisional application with claims 24-29. (See Paper No. 41 in Interference No. 103,765 entitled "Rule 615 Request for Consent to Amend Application and File Rule 53(b) Divisional Application;" copy enclosed.) In that request, Applicant Slater pointed out that the Patent Office already had decided that claims 24-29 did not correspond to the interference count, i.e. are separately patentable from the subject matter of the interference, and were not at issue in the interference. Applicant Slater therefore requested consent from the Administrative Patent Judge ("APJ") to file this divisional application to prosecute claims 24-29. The Senior Party in the interference opposed Applicant Slater's request. (See Paper No. 43 in Interference No. 103,765 entitled "Opposition to Junior Party's Rule 615 Request for Consent to Amend Application and File Rule 53(b) Divisional Application;" copy enclosed.) Applicant Slater replied to the Senior Party's Opposition. (See Paper No. 44 in Interference No. 103,765 entitled "Slater's Reply to Rydell's Opposition to Rule 615 Request for Consent to Amend Application and File Rule 53(b) Divisional Application;" copy enclosed).

On July 20, 1998, the APJ granted Applicant Slater's request. (See Paper No. 45 in Interference No. 103,765 entitled "Decision on Junior Party Slater's Motion for Cancellation of Claims Designated as Not Corresponding to the Count;" copy enclosed.) The APJ stated that "[t]he designation of the claims [24-29] as not

corresponding to the count, presupposes that they could have been developed independently from the subject matter of the count, and a decision on priority with respect to the subject matter in interference is completely independent of the patentability of the subject matter of claims 24-29."

Based on the APJ's decision, Applicant Slater filed this divisional application directed to claims 24-29, and new claims 40-56 submitted by Preliminary Amendment, that are separately patentable from the subject matter of the interference involving the parent application.

Among the information submitted herewith for the Examiner's consideration, and identified on Form PTO-1449, are materials received by Applicants' counsel from the Senior party in Interference No. 103,765 on October 5, 1998. The materials include the Declarations of Mark A. Rydell (with Exhibits A-I), David J. Parins (with Exhibit 1-6), and Joseph A. O'Brien (with Exhibits 1-2), each dated September 30, 1998.

If the Examiner has any questions regarding the above-identified interferences, the Examiner is invited to contact Applicants' counsel.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claim in the application and Applicant determines that the cited documents do not constitute "prior art" under United States law, Applicant reserves the right to present to the office the relevant facts and law regarding the appropriate status of such documents.

Applicant further reserves the right to take appropriate action to establish the patentability of the disclosed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By: 

Leslie I. Bookoff  
Reg. No. 38,084

Date: October 23, 1998